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| 10/602,108      | 06/23/2003  | Andrew Walker        | P-US-CS 1145        | 2249             |

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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3677

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/602,108

Applicant(s)

WALKER ET AL.

Examiner

Michael J. Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-25, 33-36 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-25, 33-36, 43-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12, 13, 33, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 12 and 33 recite that the cover piece is “becoming the housing”. Given that the cover piece and housing are identified as two separate elements, it is unclear how the cover piece becomes the housing. It appears as though the cover piece may be mounted in a recess in the housing such that the cover piece is flush with the housing.
3. Claims 13 and 34 depend from rejected claims 12 and 33, and include all of the limitations thereof. For this reason, these claims are also rejected.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14-25, 33-37, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooty et al (“Mooty”, U.S. Patent No. 6,308,378) in view of DeLuca et al (“DeLuca”, U.S. Patent No. 6,591,456). With respect to claims 14-16, 20, 25, 33, and 34, Mooty

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discloses a tool comprising a housing (102), a motor within the housing (column 3, line 58), and a gripping portion (104). Mooty also discloses the gripping portion (104) to have an outer surface including at least one material (at 114, 116, 118) of higher coefficient of friction than the material of the housing tool. The tool is a power tool with an output member (105). The power tool is a power drill. The handle has opposite side surfaces each defining a gripping region. Mooty fails to disclose blister pack, clamping member, chambers, and the cover member, as claimed.

6. DeLuca teaches a cushioning device for a grip of a tool comprising a blister pack (100) with first and second flexible sheets (172, 174) defining at least one gel (column 12, lines 20-22) containing chamber (106), and where the first and second flexible sheets are sealed to each other at the periphery of the gel containing chambers. DeLuca further shows a clamping, or cover, member (210, 230, 250) made of a relatively hard material compared to the gel. The area formed by the gel chambers and cover form the gripping portion. The clamping or cover member includes apertures (254). DeLuca uses this arrangement to provide a comfortable, deformable grip, that conforms to the users grip. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Mooty, such that Mooty includes the clamping member and blister pack of DeLuca around its grip, in order to provide a comfortable, deformable grip that conforms to a user's grip. A chamber enclosing the gel material (108) extends outwardly from the gripping portion (see figures 4 and 10). Both the gripping portion and chamber are simultaneously gripped. DeLuca also shows two discrete chambers extending outwardly from the side surfaces (see figures 4 and 10) and through the apertures of the cover member. The cover piece (210, 230, 250) forms at least part of the gripping portion. It is noted

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that DeLuca states the cushioning device may be used on finger held or hand held articles (column 3, lines 19-20), and defines hand held articles to include, among other things, tools (column 4, lines 47-50). The arrangement of DeLuca is such that the chambers enable part of a user's hand to contact the gripping portion and other parts to contact the chambers. DeLuca further discloses a fastening mechanism for securing the cover piece on the housing (column 8, lines 43-56).

7. With respect to claims 17 and 18, the combination of Mooty and DeLuca shows the chamber (106 of DeLuca) formed as a blister pack with gel material enclosed between upper and lower layers of flexible film (172, 174). The handle defines a recess, and the blister pack assembly is disposed in the recess (between the cover member and a base of the handle).

8. With respect to claim 19, DeLuca teaches a flexible layer as discussed above. Neither Mooty nor DeLuca show another flexible sheet disposed between the blister pack and the cover piece and having a protrusion extending through the aperture and accommodating the chamber. However, it appears, as presently claimed, this flexible sheet is just another layer on the blister pack. It is considered obvious, and within the knowledge of one having ordinary skill in the art to make to replace a single piece with multiple pieces. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify DeLuca such that there is an additional flexible sheet or layer extending through an aperture in the cover piece.

9. With respect to claims 21 and 22, the combination of Mooty and DeLuca discloses the chamber (106 of DeLuca) and cover piece (210, 230, 250 of DeLuca) to each have a curved outer surface, and the handle gripping portion includes a curved region that does not include the

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cover piece (portion 252 of DeLuca) where the cover piece has a curved outer surface that substantially merges into the curved region.

10. With respect to claims 23 and 24, DeLuca teaches the chamber to be formed as a blister pack assembly including gel material enclosed between upper and lower layers of flexible film (172, 174).

11. With respect to claim 35, the combination of Mooty and DeLuca shows the elements discussed above in paragraphs 2 and 3. Additionally, DeLuca teaches a cover piece (210, 230, 250, but neither Mooty nor DeLuca disclose the drill to comprise two cover pieces. However, separating a single part into multiple parts is considered to be within the level of one having ordinary skill in art. Doing so does not appear to create any specific utility, nor does it provide a clear advantage over the prior art. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Mooty and DeLuca such that the cover piece of DeLuca is two pieces, as such a modification does not appear to produce a new or unexpected result and is within the skill of the art.

12. With respect to claim 36, DeLuca teaches four chambers (106) encapsulating a gel material, where two chambers protrude from each said gripping region (see figures 4 and 10). The chambers are discrete from one another.

13. With respect to claims 43-45, Mooty discloses a power tool with a housing (102) having a handle (104), and motor to actuate an output member of the power tool. Mooty fails to disclose the handle to comprise a gel material and a region of material that is relatively hard compared to the gel material.

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14. DeLuca teaches a tool with a handle portion, where the handle comprises a gel material (108) and region that is relatively hard as compared to the gel material (210, 230, 250). The region defines the outer surface of the handle and the gel material protrudes outwardly through an aperture (254) formed in the region. The region is fastened to handle (252). DeLuca uses this arrangement to provide a comfortable, deformable grip, that conforms to the users grip. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Mooty, such that Mooty includes the gel material and region of DeLuca around its grip, in order to provide a comfortable, deformable grip that conforms to a user's grip.

15. With respect to claims 44 and 45, the combination discloses the handle to comprise a base (112, 114, 118 of DeLuca), and the region to comprise a cover piece (210, 230, 250) that retains the gel material on the base. The aperture (254) is formed in the cover material. The gel material is enclosed in a chamber (106 of DeLuca) formed between upper and lower layers (172, 174) of flexible film.

#### ***Allowable Subject Matter***

16. Claims 12 and 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

#### ***Response to Arguments***

17. Applicant's arguments filed March 30, 2006, have been fully considered but they are not persuasive. With respect to claim 14, applicant argues that only the cushion portion of DeLuca may be gripped when combined with Mooty. Examiner respectfully disagrees. In column 8,

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lines 46-48, DeLuca states that the cushioning member may only partially wrap around and hand held article. From this, it is seen that a use may grip both cushioning and gripping portion.

18. With respect to remaining independent claims, applicant argues they have been in amended in a manner similar to that of claim 12. Examiner notes that these claims lack a relative orientation of elements as presented in claim 12. In DeLuca, a mechanism is used to fasten cushion 102 to housing or article 112, 114. Cushion 102 may be attached to cover 210, 230, 250 and in turn mounted on to device 112, 114 by a fastening mechanism.

### ***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.



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22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mk

  
Chuck Y. Mah  
Primary Examiner